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OFFICE OF PETITIONS

In re Patent No. 7,076,920
Issue Date: July 18, 2006
Application No. 09/815,376
Filed: March 21, 2001
Attorney Docket No. 16458.050

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: **DECISION ON PETITION**
: **UNDER 37 CFR 1.78(a)(6)**
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This is a decision on the petition under 37 CFR 1.183 to suspend 37 CFR 1.78(a)(6) or in the alternative under 37 CFR 1.78(a)(6), filed February 28, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of priority to prior-filed provisional Application No. 60/191,223, filed March 22, 2000, by way of a certificate of correction filed concurrently herewith.

The petition under 37 CFR 1.183, and 37 CFR 1.78(a) is **DISMISSED** as involving moot issues

The petition under 37 CFR 1.78(a)(3) is also **DISMISSED** as involving moot issues. These petitions have been interpreted as a request for a certificate of correction under 37 CFR 1.323. The request for certificate of correction is **GRANTED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Where a claim for priority under 37 CFR § 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no

petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR § 1.78(a)(5)(ii). On the other hand, if the USPTO does not note the claim for priority to the prior-filed applications set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR § 1.78(a)(6).¹ In the present case, the Office noted the claim for priority to the prior-filed provisional application in the declaration filed with the application, as shown by their inclusion on the filing receipt.

As such, a petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 119(e) is not necessary. Petitioner should note that neither 37 CFR 1.78(a) or the Manual of Patent Examining Procedure (MPEP) create an affirmative duty on the part of the examiner. In particular, MPEP 201.11 (III)(E) states:

If the examiner is aware of the fact that an application is a continuing application of a prior application or the applicant fails to submit the reference to the prior application in compliance with 37 CFR 1.78(a) (e.g., the reference was submitted in the transmittal letter but not in the first sentence(s) of the specification or in an application data sheet), he or she should merely call attention to this in an Office action by using the wording of form paragraphs 2.15 or 2.16. (Underlining added)

The verb "should" is not a verb that requires a mandatory action nor does it create an affirmative duty on the part of the examiner. MPEP 201.11(III)(E) cannot be used as a basis for applicant to avoid 37 CFR 1.78(5)(iii) by not including the reference to the provisional application in the first line of the specification.

In view thereof, the \$400 fee for the petition under 37 CFR 1.183 has been credited back to deposit account no. 50-1491; however, the \$100 certificate of correction fee will be charged to petitioner's deposit Account No. 50-1491.

Any questions concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

This application is being referred to the Certificates of Correction Branch for processing the request for a certificate of correction in accordance with 37 CFR 1.323.


Anthony Knight
Supervisor
Office of Petitions

¹Note MPEP 201.11 (III)(D) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.